

REMARKS

This communication responds to the Office Action dated December 16, 2008. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 1, 4-7, 9-14, 16-17, 19, 22-25, and 27-29 are now pending in this Application.

§112 Rejection of the Claims

Claims 1, 4-7, 9-14, 16-17, 19, 22-25, and 27-29 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicant respectfully traverses.

First, in its "Response to Arguments," the Office asserts that "the specification does not describe the feature of disabling [the] previously enabled size control function of the display/video presentation window. Instead, the specification describes that an advertisement window (the claimed "display window") that is on top of all other windows and can not easily be closed, minimized, resized, or obscured. ... In this view, it does not mean that the advertisement window size control function is "previously enabled" as claimed. The Applicant respectfully disagrees.

As noted in the prior response, the Application as originally-filed states:

"The present invention overcomes the limitations of prior methods by employing an advertising window that is 'on top' of all other windows and cannot easily be closed, minimized, resized, or obscured. ... Some or all controls for the window are disabled at step 508. ... When the advertising is completed, the video window is returned to its previous size in step 610 and window controls may be re-enabled." Application, pg. 3, line 2 – pg. 7, line 29.

Window controls cannot be "re"-enabled unless they were previously enabled. Therefore, the specification clearly describes re-enabling disabled controls that were previously enabled, and one of ordinary skill in the art would easily understand this from the plain text of the Application, as-filed.

Second, the Office asserts that the "applicant fails to fully respond to [the] rejection of claims 7, 16, 19, and 24. The Applicant respectfully disagrees.

In its prior response, the Applicant explicitly noted the following points: (a) video windows can be manipulated using a variety of controls, (b) that one of these controls can be a resize corner 106 control (with respect to claims 7, 16, and 19), (c) that some or all of the controls, including the resize corner control 106, can be disabled so that the window may not be easily resized, and (d) that the disabled controls, including a window sizing control, can be re-enabled (which establishes, in turn, that the disabled controls were previously enabled).

Further, the Application as originally-filed states:

“During a streaming video program, an advertising insert event 500 occurs. At step 502, the display of the streaming video presentation is paused. ... After the video is paused, a new display window is opened at step 504. The window is adjusted to full screen size at step 506. **Some or all controls for the window are disabled** at step 508. ... **When the advertising is completed**, the video window is returned to its previous size in step 610 and **window controls may be re-enabled.**” Application, pg. 3, line 4 – pg. 7, line 29.

Thus, with respect to claim 24, one of ordinary skill in the art would easily understand from the Application how a display window could not be resized for a predetermined amount of time (e.g., from the time the controls for the window were disabled, until the advertising was completed, and the controls were re-enabled).

Finally, as noted in the prior response, the burden is on the Examiner to establish a *prima facie* case to maintain a rejection of non-enablement with respect to the disclosure of a patent application under 35 U.S.C. § 112, first paragraph. No such case has been properly established, because the requisite evidence has not been presented by the office to support each element of such a case.

Since the specification clearly describes the ability to disable (and re-enable) previously enabled window controls, which plainly comprise window sizing controls and operation over a predetermined amount of time, and since evidence supporting each of the elements needed to establish a *prima facie* case of non-enablement under § 112, first paragraph, has not been presented, reconsideration and withdrawal of this rejection is respectfully requested.

§ 103 Rejection of the Claims

Claims 7, 9-11 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond (U.S. Patent No. 6,698,020; hereinafter “Zigmond”) in view of Kanter (U.S. Patent Application Publication No. 2002/0032608 A1; hereinafter “Kanter”). Claims 1, 4-6, 17, 19, 22, 24, 25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Rashkovskiy (U.S. Patent No. 6,912,504; hereinafter “Rashkovskiy”) and further in view of Kanter. Claims 12-14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Siler (U.S. Patent Application Publication No. 2004/0133467 A1; hereinafter “Siler”) in view of Rashkovskiy and further in view of Kanter. However, since a *prima facie* case of obviousness has not been established by the Office in each case, the Applicant respectfully traverses the rejection of these claims.

Claims 7, 9-11 and 23 – Zigmond in view of Kanter:

Independent claims 7 and 23 recite “disabling at least one previously-enabled size control function of [a/said] video presentation window in response to said ad event signal”. The Office admits that “Zigmond fails to teach disabling at least one previously-enabled size control function of the display window in response to the ad event signal.” The Office goes on to assert that “Kanter discloses that a “user has no control over the ad window such as minimizing the ad in response to a control signal. See 0017.” Office Action, Mail Date 20081210, pg. 5.

However, this is not the same as teaching or suggesting the feature of “disabling at least one previously-enabled size control function of [a/said] video presentation window,” as claimed by the Applicant in independent claims 7 and 23. As Kanter explicitly states, the “... user has no control over the ad window ...”. Kanter, para. [0017]. In other words, the ad window size control described by Kanter was never “previously-enabled” as claimed by the Applicant.

The reply to this argument by the Office in the "Response to Arguments" section of the Office Action is somewhat confusing. It reads as follows:

"As stated, the advertisement window can not easily be closed, minimized, resized, or obscured according to the specification. This does not mean that the advertisement window size control function is "previously enabled" as claimed. In light of the specification, the feature of user has no control over the ad window such as minimizing the ad in response to a control signal in the Kanter reference

is relevant to the claimed disabling feature." Office Action, Mail Date 20081210, pg. 2.

It appears that the Office is attempting to read limitations of the claims into the specification, which is improper. Perhaps an alternative explanation by the Applicant would be helpful.

To be "previously enabled" means that the window controls were enabled prior to being disabled. Thus, the mere fact that a user has no control over a window size, for example, provides no indication whatsoever as to whether the window controls were "previously enabled" or not. In Kanter, there is no history of window controls ever being enabled (prior to being disabled). That is, the user has no control over the window size from the very beginning. Thus, it is impossible for Kanter to teach the use of advertising window controls that were "previously enabled" as claimed by the Applicant.

Since neither Zigmond nor Kanter disclose this claimed feature, no combination of these references can supply the missing element, and claims 7 and 23 should be in condition for allowance. In addition, any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03. Therefore, claims 9-11 should also be in condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 7, 9-11, and 23 under 35 U.S.C. § 103(a).

Claims 1, 4-6, 17, 19, 22, 24, 25 and 27-29 – Zigmond in view of Rashkovskiy, and further in view of Kanter:

Independent claims 1, 17, and 25 recite "disabling at least one previously-enabled size control function of said display window" (claims 1 and 17) and "adjusting said display window to a predetermined size in response to said ad insert event signal, wherein at least one previously-enabled size control function of the display window is disabled" (claim 25). The Office admits that "both Zigmond and Rashkovskiy fail to teach disabling at least one previously-enabled size control function of the display window." As noted above, the Office goes on to assert that "Kanter discloses that a "user has no control over the ad window such as minimizing the ad. See 0017." Office Action, pg. 7.

Again, this is not the same as teaching or suggesting the feature of "disabling at least one previously-enabled size control function of said display window" (claims 1 and 17) or "adjusting

said display window to a predetermined size in response to said ad insert event signal, wherein at least one previously-enabled size control function of the display window is disabled,” (claim 25) as claimed by the Applicant in independent claims 1, 17, and 25, respectively. This is because Kanter explicitly states that the “... user has no control over the ad window ...”. Kanter, para. [0017]. In other words, the ad window size control described by Kanter never was “previously-enabled” as claimed by the Applicant.

Since neither Zigmond, nor Rashkovskiy, nor Kanter disclose this claimed feature, no combination of these references can supply the missing element, and claims 1, 17, and 25 should be in condition for allowance. In addition, any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03. Therefore, claims 4-6, 19, 22, 24, and 27-29 should also be in condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 1, 4-6, 17, 19, 22, 24, 25 and 27-29 under 35 U.S.C. § 103(a).

Claims 12-14 and 16 – Siler in view of Rashkovskiy, and further in view of Kanter:

Independent claim 12 recites “disabling at least one previously-enabled size control function of said video presentation window”. The Office admits that both “Siler and Rashkovskiy fail to teach disabling at least one previously-enabled size control function of the display window.” The Office goes on to assert that “Kanter discloses that a “user has no control over the ad window such as minimizing the ad. *See* 0017.” Office Action, pg. 12.

However, this is not the same as teaching or suggesting the feature of “disabling at least one previously-enabled size control function of said video presentation window,” as claimed by the Applicant in independent claim 12. This is because Kanter explicitly states that the “... user has no control over the ad window ...”. Kanter, para. [0017]. In other words, the ad window size control described by Kanter never was “previously-enabled” as claimed by the Applicant.

Since neither Siler, nor Rashkovskiy, nor Kanter disclose this claimed feature, no combination of these references can supply the missing element, and claim 12 should be in condition for allowance. In addition, any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03. Therefore, claims 13-14 and 16 should also be in

condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 12-14 and 16 under 35 U.S.C. § 103(a).

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 16, 2009.

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